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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,794	11/23/2001	John Phillip Chevalier	SOMMR-006CUS	1594

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT PAPER NUMBER

3677

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/993,794

Applicant(s)  
Chevalier

Examiner  
Gary Estremsky

Art Unit  
3677



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 118-137 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 118-137 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other:

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## **DETAILED ACTION**

### ***Opening Remarks***

1. Inasmuch as the numbering of added claims must commence with the first consecutive number following the last pending (or previously pending) numbered claim, the new claims have been renumbered as claims 118-137. To avoid confusion, the claim dependency has also been renumbered using the new claim numbers in such a way as to be consistent with the claim dependency as submitted.

Applicant's is advised that hereinbelow and in future correspondence, the new claim numbers (118-137) must be used to avoid confusion and allow for proper entry of amendments.

### ***Drawings***

2. The drawings are objected to because the Figures' numbering should be consecutive, beginning with --Fig. 1--. Correction is required. It is noted that the specification should likewise be amended to correspond with a new figure numbering scheme.

### ***Specification***

3. The disclosure is objected to because of the following informalities:

- a. Reference to specific claim numbers in the specification should be deleted. See pages 1-6 for example.

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- b. Page 10; line 21 - --have-- should be inserted before “only”.
- c. Page 11; line 16 - “cocentric” should be replaced with --concentric--.
- d. Page 35; line 16 - second occurrence of “and held by” should be deleted.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 118-137 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Terminology chosen to define elements of the invention are confusing with respect to the functions recited as being performed by those elements. The examiner notes that the “actuation member” is used for “locking or unlocking” but that the “locking member” is used for “electric door opening”.

Applicant’s attention is further directed to the dependent claims such as 121 and 122 which further mix and confuse the functions of latching (art-accepted meaning - retaining a striker in the bolt’s opening) and locking (art-accepted meaning - preventing operation of an inside or outside operating handle from releasing the latched condition of the bolt, as previously defined).

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In that respect, Applicant's use of certain terminology in the claims is repugnant to the art-accepted meanings of those terms. The specification does not provide sufficient clarification or definition to allow the claims' scope to be clearly determined. It is suggested that the claims and the specification be amended as might be necessary to define the illustrated structure using art-accepted terminology.

Additionally as regards claim 123, it is unclear whether the claim includes the "latch bolt" and "locking member" inasmuch as the terms are phrased within a functional clause that indicates the elements are related to an intended use but are not claimed.

Additionally as regards claim 123, recitation of "the means for locking and unlocking the locking member" lacks clear antecedent basis in the claim but for the reasons noted with respect to confusing terminology, this limitation is particularly unclear.

Additionally as regards claim 126 the scope and meaning of "a rotary indexing member for driving actuators in a latch arrangement" is not clear. No particular connection is described and the meaning of the recitation is not clear after reading the specification.

Additionally as regards claim 137, 'as best understood', no "corresponding manual mechanical drive" is actually claimed as part of the invention; the recitation amounting to nothing more than a capability phrased in terms of intended use. However, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

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### ***Double Patenting***

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claim 119 and 134 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 29 and claim 31 respectively, of prior U.S. Patent No. 6,386,599 to Chevalier. This is a double patenting rejection.

Although the elements of the invention are recited in a slightly different order, after reading the specification, one of ordinary skill in the art cannot interpret the scope or meaning of the conflicting claims to *not* cover the same invention. Assuming *arguendo* that the claims are of a different scope or meaning, Applicant should clearly point out those differences.

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***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. As best understood, claims 118, 120-133, and 135-137 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,762,348 to Matsumoto.

Matsumoto '348 teaches Applicant's claim limitations for a latch arrangement including : an "electric motor" - 26, a "rotary driving and indexing member" - 29, "having at least one projection" - 30, at "least one actuation member" - 37, "means for controlling the electric motor" - including switches SS1,SS2,SS3,SS4, a "locking member" - 38.

Regardless, the examiner notes that little structure specific to a latch or lock is claimed (notable exception being the mis-named "locking member") and that no structure of a door is claimed as part of the invention. Accordingly, the functional portions of the claim carry very little weight except as to how they clearly define the claimed elements, ie, "indexing member", "actuation member", "locking member". In other words, how the claimed invention might function if connected in a certain (but unclaimed) way with unclaimed elements does not seem to further define any structure of the claimed invention.

While Applicant is free to define the invention using functional language, it should be noted that these limitations are very broad since no specific structure is defined by the present

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functional recitations whereby they amount to little more than statements of intended use. See MPEP 2114 as regards proper interpretation of functional language. See MPEP 2173.05(p) section II as regards a product and its process of use in the same claim.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The law of anticipation requires that a distinction be made between the invention described or taught by the prior art and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789.

Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

As regards claim 120 see springs 44,53.

As regards claims 129-131, one of ordinary skill in the art would recognize those structures as being inherent to the teaching of the reference.

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As regards claim 133, parts 37 and 38 read on “at least two actuation members and parts 29,30 on “indexing member”.

10. As best understood, claims 118, 120-133, and 135-137 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,411,302 to Shimada.

Shimada '302 teaches Applicant's claim limitations for a latch arrangement including : an “electric motor” - 35, a “rotary driving and indexing member” - 50,51,80, “having at least one projection” - 80, at “least one actuation member” - 90, “means for controlling the electric motor” - including 68, timer, circuit 100.

### ***Closing Remarks***

11. Applicant's arguments regarding function of the prior art are not persuasive. Applicant's attention is directed to the detailed description of Matsumoto '348 for example and particularly col 5, line 15 through col 6, line 14. The mechanism of the reference specifically includes structure for releasing the ‘latched’ condition of the pawl/bolt thereby allowing the door to open. It is long known in the art of motorized door closers that should a finger get caught in the door during the automatic closing, an option must be provided to allow the door to be immediately opened. See the Abstract of Shimada as regards this function. Contrary to arguments, the prior art relied upon specifically disclose structure for performing door opening.

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Regardless however, it should be noted that in most claims of the present Application, the invention does not include door handles, doors, latch bolts, pawls, etc. Accordingly, Applicant's arguments which are directed to how the claimed invention can or might be used with those unclaimed elements carry little weight. Additionally, it is noted that where elements are claimed as part of the invention, their interconnection is only broadly set forth in the claim. Limitations such as 'drivingly connected' or other functional descriptions of the interrelationship of the claimed elements do not require the respective elements to be directly contacting each other but must be interpreted as broad enough to include intermediary elements etc. consistent with plain meaning of the terminology used.

Inasmuch as the present claims are for a product that is defined by its structure, as set forth in the claims; it is suggested that the claims be carefully reevaluated as regards what is actually structurally included or defined as being the invention.

It is suggested that amendments be made as necessary to include additional structure; either additional elements or more particular geometric description of the elements that are now claimed and/or their interconnection in such a way as to patentably define from the prior art. It is suggested that persuasive arguments for patentability should point out any structure of the claimed product that is not taught by the prior art, as contrasted with relying upon intended use with unclaimed structures.

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***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. Pat. No. 5,639,130 to Rogers.

13. Submission of any response by facsimile transmission is encouraged. Group 3677's relevant facsimile numbers are :

- 703-872-9326, for formal communications for entry **before Final** action: or
- 703-872-9327, for formal communications for entry **after Final** action.

Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly within our examining group and will eliminate Post Office processing and delivery time and will bypass the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a Deposit Account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) \_\_\_\_ - \_\_\_\_ ) on \_\_\_\_\_  
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Typed or printed name of person signing this certificate:

\_\_\_\_\_  
\_\_\_\_\_

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(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is (703) 308 - 0494. The examiner can normally be reached on M - Th from 730 am to 600 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann, can be reached on (703) 306-4115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

- Technology Center 3600 Customer Service is available at 703-308-1113.
- General Customer Service numbers are at 800-786-9199 or 703-308-9000.

GWE

October 29, 2002

  
**GARY ESTREMSKY**  
**PRIMARY EXAMINER**